

REMARKS

The Final Office Action mailed September 25, 2002 (the response period for which has been extended), has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance. A Request for Continued Examination (RCE), a Petition for a one-month extension of time, and fees therefor are filed herewith. The present Amendment is intended as a submission required under 37 C.F.R. § 1.114 and is submitted concurrently with the RCE.

Claims 55-60 are pending. Claims 1-54 have been cancelled without prejudice to the subject matter therein. Claims 55-60 have been amended. Claims 55 and 57-59 have been amended to specifically recite that the digital data is written to or read from the digital optical memory medium. Support for the amendment is found in the specification on page 17, lines 4-7 and lines 17-19. Claim 56 has been amended to be in independent form. Claims 55 and 58-60 have also been amended to correct a typographical error.

THE CLAIMS ARE NOT OBVIOUS

Claims 55 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettijohn et al. (U.S. Patent No. 4,299,904) in view of Keller (*Science and Technology of Photography*, 1993, New York: VCH) and Russell (U.S. Patent No. 4,090,031). Claims 55 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettijohn et al. in view of Keller and Russell, further in view of Seyewetz (A Review of Dye-Toning Processes, *British Journal of Photography*, Oct. 10, 1924, pp 611-614). Claims 55 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettijohn et al. in view of Keller and Russell, further in view of Seyewetz, Peterson (U.S. Patent No. 2,308,023) and Gaspar (U.S. Patent No. 1,956,122). Claims 55 and 58-60 stand rejected under 35 U.S.C. §

103(a) as being unpatentable over Pettijohn et al. in view of Keller and Russell, further in view of Seyewetz, Peterson, Gaspar and Asami et al. (U.S. Patent No. 5,415,978). Claims 55 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettijohn et al. in view of Keller and Russell, further in view of Seyewetz, Peterson, Gaspar and Asami et al., further in view of Tauleigne et al. (U.S. Patent No. 1,059,917), Kelly (GB 160137), Crabtree (U.S. Patent No. 1,305,962), von Arx (GB 472346) or Crabtree (U.S. Patent No. 1,389,742). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

None of the cited references, taken alone or in combination, teach or suggest all the claim limitations of the present invention. In particular, none of the cited references discloses “microparticles having a particle size less than about 0.2 microns” as required by the claimed invention. The present invention uses microparticles containing silver halides in the production of optical memory media.

The Examiner cited references (Pettijohn et al., Keller, Seyewetz, Peterson, Gaspar, Asami et al., Tauleigne et al., Kelly, Crabtree ('962), von Arx, and Crabtree ('742)) showing the use of silver halides in image forming, i.e. photography, and not in digital optical memory device. Nevertheless, the Examiner combines those photography references with Russell to suggest the use of silver halides in optical memory devices. However, the combination of the references still does not teach “microparticles having a particle size less than about 0.2

microns.” On page 4 of the Final Office Action, the Examiner alleges that Keller teaches “conventional sizes for the silver particles as well as conventional sensitizing dyes” on pages 43-82, 119, and 136; however, Applicants have not been able to find any disclosure of particle size less than about 0.2 microns in those pages or the entire reference. Applicants respectfully request that the Examiner particularly point out the particular page(s) and line number(s) that particularly disclose the particle size of the present invention (less than 0.2 micron).

Although Russell discloses that data spots “may be made of different colored dyes including the subtractive wavelength dyes used in color photographic film” (see column 6, lines 45-49), Applicants have unexpectedly discovered that silver halides can be used to record digital data in optical memory devices if the particle size is sufficiently small, particularly less than about 0.2 microns. Applicants have discovered a particle size range that allows for the application of silver halides to making optical memory devices. This is not taught, suggested, or contemplated by any of the cited references. One of ordinary skill in the art would not have been motivated, from reading the cited references, to use the particle size range of the present invention (less than 0.2 microns) in making optical memory devices using silver halides.

Further, there is no motivation to combine Pettijohn et al. and Russell, because the combination of those references would have resulted in an inoperative device. In Pettijohn et al., the fluorescent dye is adsorbed by the silver halide image (col. 3, first full paragraph). By contrast, in the luminescent embodiment of Russell, the data layers 64A, 64B, 64C have different light emission wavelengths, and filters 60, 62 equal in number to the data layers are used. The process of Pettijohn et al. could not have resulted in such different layers of

different light emission wavelengths; instead, only a single layer could be formed. Therefore, Pettijohn et al. and Russell teach away from any combination of references involving the two.

Therefore, because 1) none of the reference discloses the particle size of less than about 0.2 microns; 2) Applicants have discovered an unexpected result; and 3) combining the references would result in an inoperative device, the present invention is not obvious with in the meaning of 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections.

ALLOWABLE CLAIMS

Claims 56-57 stands objected to as being dependent upon a rejected claim. Claim 56 have been rewritten in independent form and claim 57 depends from claim 56. No other outstanding objections and/or rejections are pending for claims 56-57; therefore, the claims should be allowable.

CONCLUSION

As all grounds of rejection have been addressed and overcome, entry of this Amendment and issuance of a Notice of Allowance of the pending claims, as now presented, are respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (109289-00193). In the event that a petition for an

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extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

Jacob MALKIN et al.

By: Michael D. White
Michael D. White
Registration No. 32,795

BLANK ROME LLP
Watergate
600 New Hampshire Avenue, NW
Washington, DC 20037
Telephone: 202-772-5800
Facsimile: 202-572-8398